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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,586	04/11/2001	Robert D. Johnson	1023.1122101	1496

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EXAMINER	
LEE, SEUNG H	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,586	JOHNSON, ROBERT D.	
	Examiner	Art Unit	
	Seung H Lee	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become **ABANDONED** (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41 and 43-53* is/are pending in the application.

4a) Of the above claim(s) *1-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-41 and 43-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Receipt is acknowledged of the response filed on 01 August 2003, which has been entered in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 30, 32- 41, and 43-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullis et al. (US 4,305,640, of record)(hereinafter referred to as 'Cullis') in view of Meier (US 4,669,878).

Cullis teaches an illumination system comprising a laser (1) serving as a light source generating a radiation, a light pipe (3) is located between the laser and substrate (4) wherein the light pipe is bended (8), a light beam is passing through the glass diffuser (6), the pipe can be coated for maximum reflection of the light wherein the light pipe (3) can be any suitable size and circular or other cross-sectional section (see Figs. 1 and 2; col. 2, line 4-col. 4, line 17).

However, Cullis fairly suggests that the sample source having an analyte.

Meier teaches an automated chemistry testing system for analyzing a cell (97) wherein the testing system comprising a halogen lamp (81), a wavelength calibrator

(13) for adjusting the wavelength of the radiation, a grating (91) for concentrating radiation, channeling of the radiation via several fiber-optical pathways (21-24) using a mirrors (86 and 93) and a lens (92), filter (83) for allowing passing of the light within the particular wavelength (see Figs. 1 and 2; col. 2, line 57- col. 4, line 21; col. 4, line 33- col. 8, line 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Meier to the teachings of Cullis in order to provide an improved system wherein the system can analyze the serum cell by controlling the intensity and the wavelength of the light beam. Moreover, such modification would provide a precise means for separating light into the particular wavelength wherein the particular wavelength only interfacing with corresponding particular samples therewith. Furthermore, such modification (i.e., the light pipe having a polygonal cross section and the light pipe having a S-shaped) would have been an obvious design variation, failing to provide any unexpected results, well within the ordinary skill in the art, and therefore an obvious expedient.

Although, Cullis as modified by Meier fairly suggest that the particular range of the wavelength and prediction error of clinical significance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Cullis as modified by Meier in order to adjust the wavelength calibrator to adjust the wavelength, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges

involves only routine skill in the art. *In re Aller*, 105 USPQ 233, and therefore an obvious expedient.

Although, Cullis as modified by Meier fairly suggest that the sample is biological tissue, human appendage, glucose, and alcohol, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

4. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullis Meier as applied to claim 30 above, and further in view of Friedman et al. (US 5,290,169, of record)(hereinafter referred to as 'Friedman').

The teachings of Cullis/Meier have been discussed above.

Although, Cullis/Meier teach the illumination device having a halogen lamp, they fail to teach or fairly suggest that the light source is a tungsten-halogen lamp.

However, Friedman teaches a tungsten halogen lamp (510) to produce a visible light (see Figs. 1 and 2; col. 2, line 59- col. 3, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Friedman to the teachings of Cullis/Meier in order to provide a user-friendly system since operator(s)/user(s) can aim/adjust the spectrometer with the visible light of tungsten halogen lamp for focusing accurately on the sample or confirming the successful reading of the sample, and therefore an obvious expedient.

Response to Arguments

5. Applicant's arguments filed 01 August 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to analyze sample such as serum, by controlling the intensity and the wavelength of the light beam as discussed in paragraph 3 above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[seung.lee@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Seung H. Lee
Art Unit 2876
October 27, 2003

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800